

REMARKS

The Examiner's careful search and review are appreciated. Claims 1-16 are currently pending in this application of which claims 1, 15, and 16 are independent claims. All claims were rejected in the first Office action. In particular, claims 1-11, and 16 were rejected under 35 U.S.C. 102(e) as being anticipated by Paolini (U.S. Patent No. 6,847,948). Claims 12, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paolini (U.S. Patent No. 6,847,948) in view of Kubota (U.S. Patent No. 5,034,980). In view of the present amendments and following remarks, favorable reconsideration is respectfully requested.

SUMMARY OF POSITIONS

In summary, Applicants respectfully submit that the prior art does not teach each element of each claim rejected under §102. It is a prerequisite for an anticipation rejection that each element of each claim must be taught by the reference in question. With respect to the obviousness rejections, Applicants respectfully submit that the references, even when combined, do not teach the recited claim limitations. Accordingly, favorable reconsideration and withdrawal of the rejections of the claims are respectfully requested.

CLAIMS 1-11 AND 16 ARE PATENTABLE OVER PAOLINI

As noted above, claims 1-11, and 16 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,847,948 to Paolini (hereinafter "Paolini"). In this group of claims, claim 1 and 16 are independent claims. The action states that Paolini teaches each element of independent claims 1 and 16. These claims are reproduced below:

1. A method for preventing unauthorized distribution of a software application program comprising a plurality of files downloaded from a server platform to a client platform, the client platform comprising a plurality of hardware components, over a distributed network, comprising:
 - installing a client software program on the client platform, the client software program performing a first sequence comprising:
 - establishing a communications channel between the client platform and the server platform;
 - retrieving a plurality of identifying indicia associated with the client platform;
 - formatting the identifying indicia to create a unique user identifier associated with the client platform; and

- transmitting the unique user identifier to the server platform on the communications channel;
- embedding at the server platform the unique user identifier into the software application program;
- transmitting the software application program from the server platform to the client platform; and
- installing the software application program on the client platform.

16. A system for preventing unauthorized distribution of a software application program, comprising:

- a distributed network;

- a client platform connected to the distributed network, the client platform operable for executing a client program, which is operable for generating a unique user identifier (UUI) associated with the client platform; and

- an application server platform connected to the distributed network, the application server platform operable for;

- receiving the UUI from the client platform at the application server platform and embedding the UUI into a plurality of files associated with the software application program; and downloading the plurality of files from the application server platform to the client platform.

It will be appreciated that claim 16 as amended recites “embedding the UUI into a plurality of files associated with the software application program” at the application server platform. Claim 1 recites “embedding at the server platform the unique user identifier into the software application program.” Although this general limitation existed already in claim 16, it has been clarified. The limitation of interest was added by the present amendment to claim 1.

Applicants respectfully submit that the Paolini reference does not teach or suggest this element. Indeed, the Paolini reference is concerned with initially leaving the unique machine identifier *out* of the software so that only the correct machine having that ID can regenerate the encryption key. *See* Paolini at 5:40-45. Thus, “[s]hould the program be installed on or copied to another machine, critical files cannot be decrypted due to the lack of the original machine identifier and the downloaded files are therefore useless.” *Id.* at 5:59-65.

For this reason, Paolini does not teach each element of claims 1 and 16, and it respectfully submitted that these claims are patentable over Paolini. Moreover, it is respectfully submitted that dependent claims 2-11 (and 12-14) are patentable for the same reasons since each dependent claim incorporates the limitations of its parent claim. Therefore

favorable reconsideration of and withdrawal of the rejections of these claims is respectfully requested.

CLAIMS 12, 13 AND 15 ARE PATENTABLE OVER THE COMBINATION OF PAOLINI AND KUBOTA

As noted above, claims 12, 13 and 15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Paolini in view of U.S. Patent No. 5,034,980 to Kubota (hereinafter "Kubota"). In this group of claims, claim 15 is an independent claim. Claim 15 is reproduced below:

15. A method for preventing the unauthorized distribution of software applications programs, comprising:
 installing a first control program on an authorized computer, the first control program operable for performing a first sequence in response to the control program being executed, the first sequence comprising;
 generating a unique user identifier in response to the plurality of hardware devices associated with the authorized computer; and
 transmitting the unique user identifier to a remote computer, wherein the remote computer contains a second control program operable to determine whether the first control program has previously been executed;
 in response to determining that the first control program has not been previously executed, the second control program performing a second sequence, subsequent to the first sequence, comprising;
 embedding at the remote computer the unique user identifier into the software application program; and
 transmitting the software application program to the authorized machine.

Similar to claims 1 and 16, claim 15 recites "embedding at the remote computer the unique user identifier into the software application program." As noted above, Paolini does not teach this element. Nor does Kubota cure this deficiency. For at least this reason, it respectfully submitted that claim 15 is patentable over any combination of Paolini and Kubota. With respect to claims 12 and 13 which depend from claim 1, these claims are patentable for at least the reasons cited above with respect to claim 1.

Moreover, it is respectfully submitted that the combination of Paolini and Kubota is improper since it lacks any motivation in the art. The stated reasons for combining the references is "for making determination to either decode (i.e. decrypt) the software or generate an error code." However, Paolini itself already teaches that a decision is made to

either decrypt or to fail the decryption effort. *See* Paolini at 5:59-65: “Should the program be installed on or copied to another machine, critical files cannot be decrypted due to the lack of the original machine identifier and the downloaded files are therefore useless.”

Thus, there *is no* motivation in the art since the only motivation cited is to provide a function that the primary reference Paolini already provides. As a logical and legal matter, one of skill in the art would never be motivated to modify a reference if the only benefit in doing so would be to obtain something that the reference *already* teaches.

For the reasons stated above, claim 15 is patentable over Paolini in view of Kubota. The references do alone or in combination teach the limitations of this claim. Further, the combination of the references is not motivated as would be legally required for a prima facie case of unpatentability. Moreover, it is respectfully submitted that dependent claims 12 and 13 are patentable for the reasons stated above with respect to claim 1, since each dependent claim incorporates the limitations of its parent claim. Therefore favorable reconsideration of and withdrawal of the rejections of claims 12, 13, and 15 is respectfully requested.

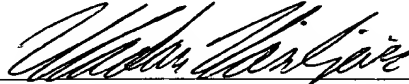
CLAIM 14 IS PATENTABLE OVER PAOLINI ALONE AS WELL AS THE
COMBINATION OF PAOLINI AND KUBOTA

Although the action states on its face that claim 14 is rejected, no rejection of this claim appears in the action. Thus, it is respectfully submitted that there has been made no prima facie case of unpatentability with respect to claim 14. For this reason as well as the reasons stated above with respect to claim 1, it is respectfully submitted that claim 14 is patentable over the cited art. Favorable consideration is requested.

Conclusion

If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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